REMARKS

In accordance with the foregoing, the specification and claims 1-8 are amended. No new matter is presented in any of the foregoing and, accordingly, approval and entry of the amended claims are respectfully requested.

Claims 1-18 are pending and under consideration.

CLAIM AMENDMENTS

Independent claims 1, 9, 16, and 18 are amended herein to respectively recite, a method, and a computer readable storage medium stored program, using claim 1 as an example, including "dividing, by a computer, a structured document represented by XML format, . . . (and) converting the structured document to a new structured document represented by XML format that added index and depth information for said structured documents by means of attribute values restricted by a namespace."

Claims 2 and 10 are rewritten in independent form. Claims 1-18 are also amended herein for form and so as to address the concerns of the Examiner.

No new matter is presented in any of the foregoing and, accordingly, approval and entry of the amended claims are respectfully requested.

ITEM 4: OBJECTION TO CLAIMS 3-8

The Examiner objects to claims 3 and 8 because of informalities. Claim 3 is amended herein to be dependent on claim 2 (instead of claim 1) and to appropriately recite a method "converting the structured document." Claim 8 is amended to recite the phrase "direction of the structured document." Withdrawal of the objection is requested.

ITEM 6: REJECTION OF CLAIMS 1-18 UNDER 35 U.S.C. §101

The Examiner rejects claims 1-18 under 35 U.S.C. §101 contending the claimed invention is directed to non-statutory subject matter. The Examiner contends that:

> the language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject mater under 35 U.S. C. 101.

Independent claim 1 is amended herein to recite a method for converting a structured document comprising: dividing, by a "computer."

Claims 16-18 are amended to recite, using claim 16 as an example, "A computer readable storage medium stored program for converting a structured document."

In addition, Applicants respectfully submit that in the precedential decision of *Ex Parte Lundgren*, Appeal 2003--2088 (October 2005), the USPTO Board of Patent Appeals and Interferences has ruled "that there is currently no judicially recognized 'technological arts' test to determine patent eligible subject matter under § 101." The Board also specifically indicated that the non-precedential decision of *Ex Parte Bowman* was not a binding decision. For this reason, it is respectfully requested that the rejection be withdrawn for lack of a foundation in the law

Summary

Applicants submit that claims 1-18, all as amended, comply with 35 U.S.C. §101 and request the rejection be withdrawn.

ITEM 7: REJECTION OF CLAIMS 1-2, 4, 6-10, 12 AND 14-18 UNDER 35 U.S.C. §102(e) AS BEING ANTICIPATED BY O'NEIL ET AL. (US 2003/0110150)

ITEMS 9-10: REJECTION OF CLAIMS 3, 5, 11 and 13 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER O'NEIL IN VIEW OF JONES ET AL. (US 2004/0205583) AND KANIE ET AL. (US 2002/0002567)

Claims 1-2, 4, 6-10, 12 and 14-18 are rejected under 35 U.S.C. §102(e) as being anticipated by O'Neil , claims 3, 5, 11, and 13 are rejected under U.S.C. §103(a) as being unpatentable over O'Neil in view of combinations of Jones and Kanie. The rejections are traversed.

Independent claims 1, 2, 9-10, 16, and 18, all as amended, respectively recite a method for converting a structured document, a method for converting and restoring a structured document represented by XML format, and a computer readable storage medium stored program, using claim 1 as an example, including "dividing, by a computer, a structured document represented by XML format, which is composed of tagged documents listed sequentially and ordered hierarchically, by tags, in a file."

Independent claims 1 and 16, both as amended, further respectively recite a method and a computer readable storage medium stored program "converting the structured document <u>to a new structured document represented by XML format</u> that added index and depth information for said structured documents by means of attribute values restricted by a namespace (emphasis added)."

Independent claim 2, as amended, further recites a method including "converting said structured document <u>into tagged documents represented by XML format</u> that added positional information indicating a position in said structured document to said divided documents (emphasis added)."

Independent claim 9 further rejects a method including "converting the structured document to <u>a new structured document represented by XML format</u> that added index and depth

information for said structured documents by means of attribute values restricted by a namespace (emphasis added)."

Independent claim 10 further recites a method "restoring said structured document represented by XML format by deleting said positional information from said tagged documents, wherein said converting comprises adding said positional information as attribute information in said tag."

Independent claim 18 further recites a computer readable storage medium stored program including "converting the structured document to a new structured document represented by XML format that added index and depth information for said structured documents by means of attribute values restricted by a namespace."

Applicant submits that O'Neil does not support an anticipatory-type rejection by not discussing features recited in the present application's independent claims as a whole. As set forth in MPEP §706.02 entitled Rejection on Prior Art, anticipation requires that the reference must discuss every aspect of a claimed invention.

Each of the independent claims as amended herein recites converting a structured document of XML format into a tagged document of XML format added to a positional information.

O'Neil does not teach a retention of an XML format and converting a structured document of XML format into a tagged document still of XML format .

Rather, O' Neil teaches converting a XML document into a tree structured document. As shown in Fig. 4, a tagged document is converted the tree structured document of a table format by adding an or-depth of the XML structure so as to facilitate editing, such as insert and delete. That is, O'Neil merely teaches converting a XML document into a Document Object Model (DOM) tree that is not in XML format. See, for example, paragraphs [0040]-[0047] in which O'Neil teaches:

> the number of dot-separated numbers in position identifiers 325 identifies the "depth" of a node within tree 300. ... Relation 400 comprises a plurality of rows in a relation (or relational table) 412-424 Column 432 has the name "ORDPATH," and represents the ORDPATH position identifiers 325 of the nodes of tree 300. Column 434 contains an integer that identifies the given name for each of the nodes in tree 300 . . . Using the ORDPATH position identifier stored in column 432, the hierarchical structure of data 200 is readily discernible from relation 400 and can be reconstructed from relation 400. Furthermore, with ORDPATH used as the (clustered) primary key of relation 400, the rows will actually sit on disk in the appropriate document order, making searches in a range within the document more efficient.

Further, features recited by the present invention are not taught by even an *arguendo*

combination of the cited art. As set forth in MPEP §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F. 2d 1981, (CCPA 1974)."

According to an aspect of this invention, a structured document of XML format is converted into a tagged document of XML format added to a <u>positional</u> information.

Jones merely teaches (see, for example, paragraph [0020]) converting a normal document of MSWORD into a XML document by adding a name space.

Kanie merely teaches (see, for example, paragraphs [0056]- [0062]) extracting a difference portion and a common portion between an original XML document and an updated XML document to manage a history of XML document.

Summary

Since features recited by each of the independent claims 1, 2, 9-10, 16, and 18 (and respective dependent claims) are not taught by the cited art and *prima facie* obviousness is not established, the rejection should be withdrawn and claims 1-18 allowed.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: _April 20, 2006_   By: _Paul W. Bobowiec_
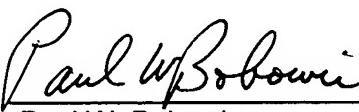
Paul W. Bobowiec
Registration No. 47,431

1201 New York Avenue, NW, 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501